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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/392,270	09/09/1999	JASON A. POIRIER	1-21036	9927

27210 7590 02/06/2004

MACMILLAN, SOBANSKI & TODD, LLC
ONE MARITIME PLAZA - FOURTH FLOOR
720 WATER STREET
TOLEDO, OH 43604

EXAMINER

NGUYEN, TRINH T

ART UNIT PAPER NUMBER

3644

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/392,271

Applicant(s)

GARTNER ET AL.

Examiner

Trinh T Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 15, 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 1/2/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of prior Patent No. 6,477,774 has been reviewed and is accepted. The terminal disclaimer has been recorded. Furthermore, it is noted that the double patenting rejection for claims 1-7, 15, and 16, in Paper No. 22, have been withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-7, 15, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Applicant's Admitted Prior Art** (as set forth in lines 13-29 of page 1, all of pages 2 & 3, lines 1-10 of page 4, lines 19-24 of page 6, lines 1-22 of page 7, lines 16-26 of page 8, and lines 22-25 of page 9; hereinafter is referred to as **AAPA**) in view of **Mills et al.** (US 4,362,578).

AAPA discloses that it is old and well known to manufacture a vehicle frame structure by: providing a closed channel workpiece member; performing a retrogression heat treatment process to softening the workpiece member; and while the workpiece

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remains softened, deforming the workpiece member to form a vehicle frame structure (see lines 17-28 of page 3 of the specification). Further note that the use of inductive heating coil and quenching ring are well known and conventional as admitted by the Applicants in lines 18 & 19 of page 8 and line 23 of page 9.

AAPA teaches the claimed invention except to mention that when performing the heat treatment process on the workpiece the inductive heating coil and the quenching ring are moved in a continuous and longitudinal manner from one end of the workpiece to the other end.

Mills et al., on the other hand, teach a method of hot working metal workpieces by using inductor heating coil to heat the workpieces into a desirable temperature, and at the same time softening the workpieces. Mills et al.'s method further allow the metal workpieces to be moved in a continuous and longitudinal manner through the heating coil so as to vary the rate of heat along the length of the workpieces (see lines 3-40 of col. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of AAPA so as to include the use of induction heating coil assembly in which the workpiece can be heated in a continuous and longitudinal manner, as taught in Mills, in order to vary the rate of heat along the length of the workpiece and also to easily and economically deform a workpiece member due to its low and/or high threshold temperatures.

Regarding claims 4-7, AAPA sets forth the invention as cited above with the exception of the orientation of the workpiece. It would have been obvious to one of ordinary skill in the art at the time the invention was made that whether the heat

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treatment process is performed by suspending and/or supporting the workpiece member vertically or horizontally by an upper end and/or lower end is a matter of design choice since no significant problem is solved or unexpected result obtained by supporting the members in the orientation claimed versus that taught by the prior art.

It is noted that the Applicants recite specific article design limitations in claims 15 and 16, i.e., specific material limitations, however, such limitations must result in a manipulative difference in the recited process steps as compared to the prior art. In this instance these design limitations are held to be obvious and not given patentable weight in these method of manufacturing claims as such limitation(s) do not result in any difference in the *claimed* manufacturing process.

Response to Arguments

4. Applicant's arguments filed 1/2/04 have been fully considered but they are not persuasive.

5. In response to Applicant's argument that Mill et al.'s heat treatment process is different from the claimed retrogression heat treatment process, it is noted that the Mill et al. reference was merely cited to show that it is old and well known to heat treating metal workpieces by using inductor heating coil to heat the workpieces into a desirable temperature, and at the same time softening the workpieces, and that the metal workpieces are allowed to be moved in a continuous and longitudinal manner through the heating coil so as to vary the rate of heat along the length of the workpieces (see lines 3-40 of col. 3). Furthermore, as shown in lines 17-28 of page 3 of the

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specification, it is noted that the retrogression heat treatment process as claimed is old and well known heat treatment process.

Conclusion

6. This is a continuation of applicant's earlier Application No. 09/392,270. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

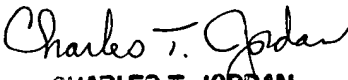
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T Nguyen whose telephone number is (703) 306-9082. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan can be reached on (703) 306-4159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ttn
2/4/04


CHARLES T. JORDAN
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